

REMARKS

This amendment responds to the office action mailed July 8, 2005. In the office action the Examiner:

- rejected claims 9-16 under 35 USC 101 as the claimed invention is directed to non-statutory subject matter;
- rejected claims 1-5, 7-20 and 22-24 under 35 USC 103(a) as being unpatentable over Dobbs in view of Koppolu et al.; and
- rejected claims 6 and 21 under 35 USC 103(a) as being unpatentable over Dobbs in view of Koppolu as applied to claims 1-5, 7-20 and 22-24 and further in view of Weinberger et al.

After entry of this amendment, the pending claims are: claims 1-24.

Summary of Phone Interview with the Examiner

The undersigned attorney and Yalei Sun held a telephone interview with the Examiner Brinich on September 21, 2005.

With regard to the claim rejections under 35 USC 101, the undersigned attorney brought the Examiner's attention to the following specific language in the preamble of claim 9, "the computer program product comprising *a computer readable storage medium*", and argued that claims 9-16 have satisfied the subject matter requirement under 35 USC 101. The Examiner agreed.

With regard to the claim rejections under 35 USC 103(a), the undersigned attorney first pointed out that the test pattern of Dobbs is *a single document*, not a list of specific documents recited in claim 1. This single document is printed repeatedly on different print media using different print modes to determine what print mode is most appropriate for a particular print medium. The registry of Koppolu establishes a link between *a specific application program* and *a document type having a specific file extension*, not a list of specific documents as recited in claim 1. Neither the test pattern of Dobbs nor the registry of Koppolu teaches or suggests a driver-test data structure that identifies a plurality of applications and a list of specific documents as recited in claim 1. Also, neither Dobbs nor Koppolu teaches "associating each of a plurality of the identified application with specific respective documents." (see claim 1)

The Examiner then suggested that FIG. 6 of Koppolu teaches a data structure that identifies a plurality of applications and a list of specific documents. After carefully reviewing Koppolu, the undersigned attorney respectfully disagreed with the Examiner's reading of Koppolu. FIG. 6 and its associated description (col. 17, lines 26-53 of Koppolu) teach a method of printing a group of documents with consecutive page numbers using *a single client application program* such as the Binder application in the Microsoft Office, and there is no teaching or implication in Koppolu of a driver-test data structure that identifies *a plurality of applications and a list of specific documents*.

The Examiner requested the undersigned attorney to prepare a response to the Office Action dated July 8, 2005 and agreed to reconsider the pending claims in light of the aforementioned arguments.

Claim Rejections – 35 USC 101

The Examiner rejected claims 9-16 under 35 USC 101, arguing that the claimed invention is directed to functional descriptive material, a non-statutory subject matter. Applicant respectfully disagrees.

Claim 9 recites, in pertinent part, “[a] computer program product for use in conjunction with a computer system, the computer program product for testing a print driver in a computer system, the computer program product comprising *a computer readable storage medium* and a computer program mechanism embedded therein...” (Emphasis added). The computer program product of claim 9 is neither a program written on paper nor a program simply contemplated and memorized by a person. Rather, the computer program product is fixed on a computer readable storage medium, which is exactly suggested by the Examiner. Therefore, the rejection under 35 USC 101 should be withdrawn.

Claim Rejections – 35 USC 103(a)

The Examiner rejected claims 1-5, 7-20, and 22-24 under 35 USC 103(a) as being unpatentable over Dobbs in view of Koppolu et al. Applicant respectfully disagrees.

The test pattern of Dobbs is not equivalent to a driver-test data structure of the present invention. The test pattern does not identify a plurality of applications and a list of specific

documents as the driver-test data structure of claim 1 does. Nor does the test pattern include information associating each identified application with one or more specific respective documents.

The test pattern of Dobbs is actually *one predefined document* that “provid[es] as illustrated [in FIG. 1] plural discrete images corresponding to plural predefined print modes.” (Col. 2, lines 36-38 of Dobbs). Dobbs only teaches “*a set of sample images* produced by different print modes” from a single test pattern (Col. 1, lines 38-40 of Dobbs). But Applicant fails to find any text in Dobbs supporting the Examiner’s reading that the test pattern corresponds to *a set of documents*.

Nor does Koppolu teach or suggest a driver-test data structure that (1) identifies a plurality of applications and a list of specific documents and (2) includes information associating each identified application with one or more specific respective documents.

The Windows registry in Koppolu only associates *document types*, not specific documents, with applications. For example, the registry on col. 2, lines 1-5 maps all documents having the file name extension “.doc”, i.e., all MS-WORD documents, to the application “winword.exe”. But the registry does not associate *any specific document* with the application, contrary to the requirements of the pending claims. Similarly, the registry does not associate specific documents with a print driver for testing the print driver or for any other purpose.

FIG. 6 of Koppolu and its associated description (col. 17, lines 26-53 of Koppolu) teach a method of printing a group of documents with consecutive page numbers using *a single client application program* such as the Binder application in the Microsoft Office. The client application program calls its get page information member function to retrieve the number of pages in each document (step 253). Using this information, the client application program calls its set initial page number member function to specify the first page number of the first document (step 254). The client application program then repeatedly calls its print member function and sets the initial page number for the first page of a next document until all the documents have been printed (steps 255, 256 and 257). Clearly, this method does not teach or imply a driver-test data structure that identifies *a plurality of applications* and *a list of specific documents*.

Therefore, claims 1-5, 7-20, and 22-24 are patentable over Dobbs in view of Koppolu.

Since claims 6 and 21 have been rejected by the Examiner using the same arguments re claims 1 and 17, they are patentable for at least the same reasons mentioned above.

Claims 6 and 21

Weinberger teaches a method for incorporating additional indicia, e.g., "CONFIDENTIAL", into a document image generated by a print driver without modifying the source of the document image, e.g., a Word document, such that the indicia can appear on a printed copy of the document. Weinberger does not teach or suggest anything related to the testing of a print driver, and more specifically it does not teach the features of the presently claimed invention identified above as not being present in either Dobbs or Koppolu or any combination thereof. Therefore, claims 6 and 21 are patentable over Dobbs in view of Koppolu as applied to claims 1-5, 7-20 and 22-24 and further in view of Weinberger et al.

In light of the above amendments and remarks, the Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney if a telephone call could help resolve any remaining items.

Respectfully submitted,

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